

### REMARKS

Certain amendments to the drawings and written descriptions submitted in an After Final office Action filed on October 10, 2006. According to the Advisory Action mailed October 18, 2006, these amendments were entered in the Application and Applicants presume that the objections to the drawings set forth in the August 9, 2006 Final Office Action ("the FOA") are withdrawn.

Claims 1, 2, 4-7, 9, 12-15, 17, 19 and 20 stand rejected in the FOA under 35 U.S.C. §102 as anticipated by U.S. Patent No. 4,262,991 to Wagener et al. ("Wagener") and claims 8, 16 and 18 stand rejected under 35 U.S.C. §103 as unpatentable over Wagener in view of U.S. Patent No. 5,900,708 to Den Engelse et al. ("Den Engelse").

The FOA objects to claims 10 and 11 as depending from rejected claim 9 but the FOA indicates that the claims include allowable subject matter.

In this submission, claims 1, 7, 9-11, 15, 17 and 20 are amended; claims 21-23 are added.

#### ***The Allowable Subject Matter***

Applicants thank the Examiner for acknowledging the allowable subject matter in claims 10 and 11. Applicants have amended claims 10 and 11 to include all elements of independent claim 9 as previously presented. Therefore, Applicants respectfully submit that claims 10 and 11 are now allowable.

#### ***The §102 and §103 Rejections***

Applicants respectfully submit that amendments to the independent claims presented in this submission render the rejections of the claims moot. Applicants have amended the claims for the sole purpose of expediting prosecution of the Application. Applicants maintain that the claims as originally presented were allowable over the art of record and reserve the right to pursue the broader claims in a continuation application.

Applicants respectfully submit that the amendments provided in this submission more clearly distinguish the claims in the Application from Wagener, notwithstanding the unreasonably broad interpretation of Wagener presented in the FOA. According to the FOA, Wagener has a base plate that is not shown in the drawings but is equivalent to a precision stage. However, the interpretation in the FOA is derived from a misapprehension of Wagener's written description that was caused by inappropriate transposition of Wagener's Abstract and claim terminology into the written description of Wagener.

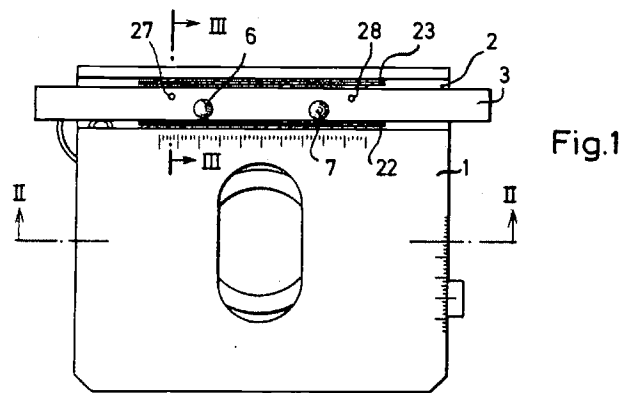


Fig.1

Wagener

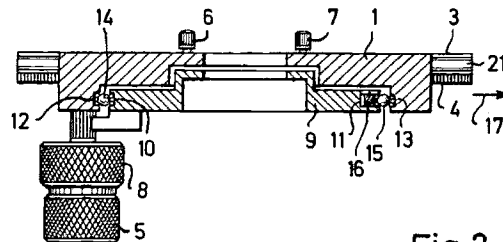


Fig.2

The misapprehension of Wagener's teaching is based on an inconsistent use of terms between the Abstract/claims and the written description of Wagener. In Wagener, consider the Abstract with reference to Figs. 1 and 2 (reproduced above). The Abstract states:

A mechanical stage for microscopes [that] includes a base plate, a stage plate displaceable along the base plate in one coordinate direction, and an object plate displaceable along the stage plate in a second coordinate direction and includes means for automatically maintaining the base plate, the stage plate, and the object plate in proper alignment with respect to a fixed reference.

It is clear that Wagener's object guide 3 is referred to as "an object plate" in the Abstract and Wagener's stage plate 1 is referred to as "a stage plate" in the Abstract and that Wagener's "fixed part 9" can only be the "base plate" of the Abstract. Applicants observe that Wagener's claim 4 expressly requires the base plate to be fixed and the Abstract requires that its stage and object plates are displaceable. Consequently, the FOA improperly states that Wagener's base plate is not shown when, in fact, Wagener shows the base plate as a fixed part 9 in Fig. 2. Therefore, the rejections of the claims in the Application were improperly made in the FOA because they relied on misconstrued prior art.

Nevertheless, Applicants have submitted amendments that further distinguish the claims from the cited art. Independent claim 1 has been amended to include a requirement of a movable portion relative to a fixed portion, where the movement is operative to position a selected area of a substrate within a precision travel range of a precision stage. Wagener does not teach or suggest a precision stage having a precision travel range. Wagener explicitly teaches that the base plate relied upon in the FOA as a precision stage is adapted for *fixed mounting* on a microscope frame. Wagener, claim 4, Fig. 2 and see col. 2, lines 7-12 and lines 51-53. Furthermore, Wagener provides no substantive teaching related to its Abstract-described base plate and nothing in Wagener suggests that its fixed part 9 is a precision stage having a precision travel range (or even a non-precision travel range). Consequently, the amendment to the claim precludes the broad interpretation applied to Wagener in the FOA and the rejection of claim 1 should be withdrawn.

Claim 4 depends from and further limits claim 1 by requiring the fixed and movable portions to have respective apertures that cooperate to form a window in the claimed substrate holder. New claim 23 requires a correspondence between the window and the precision travel range of the precision stage. Even under the excessively broad interpretation adopted by the FOA, Wagener does not teach or suggest such window or correspondence.

Independent claims 9 and 17 have also been amended and now require a precision stage having a precision travel range. As discussed *supra*, Wagener does not teach or suggest a precision stage having a precision travel range. Moreover, claim 9 also requires provision of a movement that positions a selected area of a substrate within a precision travel range and claim 17 requires positioning a desired area of a substrate within a precision travel range of a precision stage. Such positioning of a selected or desired area within a precision travel range of a precision stage is not taught or contemplated by Wagener.

### ***The §103 Rejections***

Regarding claims 8, 16 and 18, Den Engelse does not cure the deficiencies of Wagener. Den Engelse is used merely for the proposition that it would have been obvious to add Den Engelse's motor to Wagener in order to automate movement. Because no combination of Wagener and Den Engelse teaches all elements of the independent claims, it is unnecessary to address the motivation or efficacy of combining Wagener and Den Engelse. Applicants respectfully submit that claims 8, 16 and 18 are allowable for at least the reason that the base claims from which they depend are allowable.

***Claim Amendments***

In addition to the claim amendments discussed above, Applicants have amended claims 7, 15 and 20 for consistency with the amended independent claims. Claims 21 -23 are added. The claim amendments add no new subject matter to the Application and are fully supported in the Specification and Drawings.

**CONCLUSION**

All objections and rejections having been addressed, and in view of the foregoing, the claims are believed to be in form for allowance, and such action is hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to contact the undersigned at the telephone number listed below. Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,  
PILLSBURY WINTHROP SHAW PITTMAN LLP



---

ANTHONY G. SMYTH, Reg. No. 55,636  
Tel. No. 858 509.4007

Date: July 19, 2007  
12255 El Camino Real, Suite 300  
San Diego, CA 92130-4088  
(619) 234-5000